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No. 83-367

IN THE

Supreme Court of the United States

OCTOBER TERM, 1983

JOHN C. HARDEN,

Petitioner,

—vs.—

E. I. DU PONT DE NEMOURS & CO.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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PARTIES TO THE PROCEEDING

Petitioner: John C. Harden
Respondent: E. I. du Pont de Nemours and Company*

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* Following is a listing naming all parent companies, subsidiaries (except wholly owned subsidiaries) and affiliates of respondent, E. I. du Pont de Nemours and Company:

Airport Limited Partnership
Allied Eneabba Ltd.
Concord Limited Partnership
Desarrollo Quimico Industrial, S.A.
Ducilo S.A.
Du Pont Canada Inc.
Twin Peak Resources
Mitsui Fluorochemicals Company, Ltd.
Mitsui Polychemicals Company, Ltd.
Bontec Company, Ltd.
EDOBI
Hiroshima Sekisui
Kyokuto Kobunshi Company, Ltd.
Kyushu Taiyo Kasei Company, Ltd.
KZM Company, Ltd.
Muromachi Company, Ltd.
Taiyo Kasei Company, Ltd.
PD Magnetics B.V.
Showa Neoprene K.K.
Butachimie
Syngas Company
Toyo Products Company, Ltd.
Adela Investment Company S.A.
Aviones B.C., S.A. de C.V.
Derivados Macroquimicos, S.A.
Derivados Sinteticos, S.A. de C.V.
Gemeinnutzige Wohnungsbau GmbH
Geomina, S.A.
Halocarburos, S.A. de C.V.
La Domincia, S.A. de C.V.
Nylon de Mexico, S.A.
Inser, S.A.
Univex, S.A.
Pigmentos y Productos Quimicos, S.A. de C.V.
Quimica Fluor, S.A. de C.V.
Tetraetilo de Mexico, S.A.
Wilmington Trust

Juliana Mining Co.
Big Sky of Montana Realty, Inc.
Calcasieu Chemical Corporation
Cit-Con Oil Corporation
Conch International Methane Ltd.
Condea Chemie GmbH
T.A.L.
Petroquimica Espanola, S.A.
Conch L.N.G.
Conoco Exploration, Ltd.
K/s Startfjord Transport A.S. & Co.
Stratfjord Transport A.S.
Benzene Marketing Co. Ltd.
Associated Petroleum Terminals Ltd.
Cliffe Storage Ltd.
Crude Oil Terminals (Humber) Ltd.
Humber Oil Terminals Trustee Ltd.
Petroleum Storage Ltd.
Warwickshire Oil Storage Ltd.
Bishop Coal Company
Conrhein Coal Co.
Cardinal River Coals, Ltd.
Neptune Bulk Terminals (Canada) Ltd.
Contochu Inc.
Harmar Coal Co.
Itmann Coal Co.
Mathies Coal Co.
Tongue River Holdings, Inc.
Tongue River Railroad
Carbon Black Espanola, S.A.
Compagnie Francaise du Carbon Black, S.A.
Continental Columbian Carbon Nederland, N.V.
Lucky Continental Carbon Co., Ltd.
Toyo Continental Carbon, Ltd.
Oasis Oil Co. of Libya, Inc.
Colonial Pipeline Company
Dixie Pipeline Company
Explorer Pipeline Company
Lake Charles Pipe Line Company
Pioneer Pipe Line Company
Platte Pipe Line Company
Seadock, Inc.
Seaway Pipeline, Inc.
Texas Offshore Port, Inc.
West Shore Pipe Line Company
Yellowstone Pipe Line Company
Felix Oil Company

Kettleman North Dome Assoc.
Long Beach Oil Development Company
Maritime Protection A/S
A/S Soties Plass 2
Maritime Protection (PTE) Ltd.
Maritime Protection Inc.
Nippon Aluminum Alkyls, Ltd.
Nissan-Conoco Corporation
Oil Shippers Service, Inc.
Oberrheinische Mineraloelwerke GmbH
PASA Petroquimica Argentina, S.A.
Petrocokes, Ltd.
Petroleum Terminals, Inc.
Iranian Investment Corp.
Iranian Oil Participants Ltd.
Iranian Oil Services (Holdings) Ltd.
Iricon Agency, Ltd.
Southern Facilities, Inc.
Sulitjelma Elektronikk A/S
The Standard Shale Products Company
Tidelands Royalty Trust
Westamarin A/S
Stavangereske Westmarin A/S
Petrosar Limited

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ON PETITION FOR A WRIT OF CERTIORARI TO
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RESPONDENT'S BRIEF IN OPPOSITION

COUNTERSTATEMENT OF THE CASE

A. The Case Below

On March 26, 1979, petitioner, John C. Harden, filed an eight count verified complaint against respondent, E. I. du Pont de Nemours and Company ("Du Pont"), his former employer. Jurisdiction of the district court was based on diversity of citizenship. (Petition Appendix 6, 16). No constitutional claims or causes of action based on federal law were asserted in the complaint or argued below.

The seventh count of the complaint asserted a state law claim for wrongful termination of employment; the remaining counts asserted state law claims on various contract, unjust enrichment and tort theories based on the allegation that Du Pont failed to compensate Harden adequately for work performed by him in the course of and as part of his employment with Du Pont during the late 1950's and early 1960's, and involving three distinct subject areas: differential thermal analyis, gas chromatography and instrument sales.[1] (Petition Appendix 6, 16-17).

In the district court, the extent and value of Harden's contributions in all three subject areas were sharply contested, as was the reason for the termination of Harden's employment.[2] However, respondent's summary judgment motions did not require resolution of any fact issues. Instead, summary judgment was sought on the grounds: (1) that petitioner's claims relating to his alleged entitlement to bonuses were time-barred under the applicable Delaware statute of limitations and by the doctrine of laches, and (2) that because petitioner was an employee at will and could be terminated with or without cause, his asserted cause of action for wrongful discharge failed to state a claim under New Jersey law.

The district court in well-reasoned opinions granted respondent's motions. It held that New Jersey would apply Delaware law to determine the timeliness of the complaint, and its own

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1 Petitioner is a named co-inventor with other Du Pont employees on three patents relating to differential thermal analysis. Although his work relating to these patents is only one of the three subject areas for which petitioner claimed he was due bonuses, the patent-related claims are the only subject raised in the Petition to this Court.

2 Respondent takes exception to the Petition's extensive misstatement and mischaracterization of the facts of this matter, and therefore sets forth its Counterstatement of the Case. Note, however, that since the lower court's disposition of this matter did not require resolution of factual issues, no attempt is made to address all the Petition's misstatements.

law on the wrongful discharge claim. The district court concluded that all petitioner's claims arising out of the failure of Du Pont to award him additional bonuses accrued by 1970 at the latest, and were time barred whether Delaware's one-year statute or its three-year statute of limitations[3] applied, and that any equitable claims were barred by the doctrine of laches. (Petition Appendix 18-25). The district court further held that even if petitioner had been discharged as a result of his persistence in seeking bonuses, the discharge was not actionable under New Jersey law. (Petition Appendix 10-12). The court of appeals summarily affirmed. (Petition Appendix 3-4).

B. Facts Relevant To Choice Of Law And To The Untimeliness Of Plaintiff's Complaint

Harden was employed at Du Pont's main research facility—the Experimental Station in Wilmington, Delaware—until March 1976, when he was transferred to Du Pont's Jackson Laboratory in Deepwater, New Jersey. His job essentially was to do technician work assisting doctoral chemists and engineers. Until 1976, Harden's principal residence was in Delaware; thereafter and at the time of his termination on March 6, 1978, Harden was a New Jersey resident. (Petition Appendix 20).

Despite his contention that his efforts as a Du Pont employee were inadequately compensated, it was undisputed that during the course of his employment with Du Pont, Harden received regular pay increases, including merit increases, and several bonuses including valuable suggestion awards for two of the areas which were the subject of his complaint.[4] (Verified Complaint, ¶¶ 15, 37, 65). He also received a number of

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3 10 Del. C. § 8111 and 10 Del. C. § 8106, the one year and the three year statutes, respectively, are set forth in the Appendix to this brief.

4 Indeed, Harden still receives from Du Pont: "a. Pension checks; b. Basic Blue Cross and Blue Shield Coverage; c. Non-Contributory Life Insurance" and various additional benefits. (Harden Affidavit, 1/23/81, ¶ 27).

promotions. Harden, however, was dissatisfied, and repeatedly promoted himself for additional bonuses under Du Pont's Special Compensation Plan, also known as the "A" Bonus Plan. His unsuccessful efforts to secure further bonuses formed the basis for his lawsuit against Du Pont.

All the work at issue in the case at bar, and for which petitioner claimed bonuses were due him, was performed by 1962. His work in gas chromatography took place in the late 1950's. (Verified Complaint, ¶ 22). His alleged contribution in the second area for which bonuses were sought—instrument sales—was completed by 1960. (Verified Complaint, ¶¶ 28, 31). His work in differential thermal analysis was completed by 1962, and initial applications for all patents in this area were filed by that year. (Verified Complaint, Exhibits A, B, and C; Harden Deposition, 2/27/80, pp. 4.151-4.152).

Under the terms of the "A" Bonus Plan, recommendations for awards are to be made promptly after the accomplishment, and no later than three years after initial operation. In the case at bar, initial operation took place by the mid 1960's. The instrument sales venture was launched in 1961. Differential thermal analysis equipment was displayed at trade shows and put into commerical operation by 1962 and 1963. Petitioner's co-inventors on the subject differential thermal analysis patents received "A" bonuses in 1965.

Harden's verified complaint and his deposition testimony established that he was rejected for "A" Bonuses by 1970 at the latest. As the complaint alleged:

> [A]t least three requests made on behalf of Harden for an award under the "A" bonus plan were turned down by the du Pont Company. (Verified Complaint, ¶ 19).
>
> The request for an "A" bonus award was initially and improperly turned down in the Spring of 1970. • • • On or about May 25, 1970, Sebastian Masterangelo (sic), Harden's supervisor at that time, reapplied for an "A" bonus award on behalf of Harden • • •

> Approximately 3 months later, the "A" bonus request was improperly rejected * * * (Verified Complaint, ¶¶ 39, 41, 42).

Harden's deposition testimony confirmed that by 1970 his bonus requests had been rejected twice, that he knew it, and felt the rejections were wrongful.

> "Question: Who was the first one to tell you it was turned down? I am talking about the [request] for an A-bonus for your work on Differential Thermal Analysis.
>
> "Answer: If I recall correctly, it was Steve Thayer.
>
> "Question: What did he say, to the best of your recollection, what did you say to him?
>
> "Answer: It's hard to put it in words, but the best I can remember is, 'Your A-Bonus is turned down because of a letter we received back from a man by the name of Piper.' "
>
> * * *
>
> "Question: Take a look at Plaintiff's Exhibit 48, December 23, 1968, and I ask you is that the letter they showed you. . .?
>
> "Answer: That's correct."
>
> * * *
>
> "Question: Does it refresh your recollection that . . . it was sometime in December '68 you were given that advice?
>
> "Answer: Yes."
>
> (Harden Deposition, 2/27/80, pp. 4.140-4.145).

Shortly after his bonus request was rejected the first time, Harden submitted to his superiors a handwritten memorandum dated April 11, 1969 wherein he stated his dissatisfaction with Du Pont's refusal to award him an "A" Bonus.[5] As he wrote:

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5 The rejection was based on an assessment that Harden's contributions were "small or none at all." (Deposition Exhibit P-48). Compare this assessment with petitioner's undocumented assertion that his ideas

"I don't intend to let this go by and will go to all ends to reach my goal." (Deposition Exhibit D-3-1).

In January and April 1970, Harden received from Du Pont two $500 awards, one for his written suggestion that Du Pont undertake to market scientific instruments developed in the company, and the other for his contribution to Du Pont's research in differential thermal analysis. (Verified Complaint, ¶¶ 15, 37). He felt at that time that he was entitled to further bonuses under the "A" Bonus Plan, and that the time was ripe for their award. Harden asked his then superior, Dr. Mastrangelo, to put forward another request for an "A" Bonus for him. He did, it was again rejected, and Harden so advised in or about September 1970. (Harden Deposition, 2/28/80, pp. 5.140-5.143).

In the years between 1962, when all the work at issue in this suit was completed, and 1979, when suit was commenced, three key Du Pont witnesses died, including two men who were Harden's direct superiors during the gas chromatography work and at the time the instrument sales suggestion was made. Numerous documents dealing with the issues raised by Harden were lost or destroyed. Many potential witnesses retired or left Du Pont.

Based upon the foregoing facts, the district court concluded that petitioner's asserted causes of action based on Du Pont's refusal to award him "A" Bonuses accrued no later than 1970, and that the suit commenced on March 26, 1979 was time-barred. (Petition Appendix 24-25).

"earned hundreds of millions of dollars for Du Pont." (Petition 3). The Petition herein is replete with such inflammatory statements which are devoid of record or other support. All pretrial discovery on this and other damages issues was stayed by court order of December 3, 1980. Thus, apart from any dispute as to the intrinsic value of any of petitioner's work, there is simply no basis for calculating earnings traceable to Harden's contributions.

C. Facts Relevant To The Wrongful Discharge Claim

Petitioner alleged that he was fired "contrary to due process of law and in breach of [his]employment agreement." (Verified Complaint ¶ 67). Specifically, Harden asserted he was terminated for his repeated attempts to secure additional compensation for his work. Du Pont's position was that Harden was fired because the company discovered he had wrongfully removed large quantities of valuable equipment from Du Pont's plants. (Petition Appendix 10).

In granting respondent summary judgment on this claim, the district court accepted petitioner's contentions, but nonetheless found no actionable claim. Harden's employment with Du Pont was for an indefinite term. Under New Jersey law he was therefore an employee at will and could be discharged with or without cause so long as no clear mandate of public policy were thereby violated. The district court concluded that petioner's discharge involved no public interest but only his private interest in obtaining additional monetary compensation for work performed in the course of employment. The court held that such a claim was not cognizable under New Jersey law. (Petition Appendix 8-10).

REASONS FOR DENYING THE WRIT

Resolution of the constitutional issues advanced by petitioner is unnecessary to decision of this case inasmuch the court of appeals and district court rendered correct decisions under applicable state law on the dispositive issues of petitioner's untimeliness in commencing suit and the complaint's failure to state a claim for wrongful discharge. Moreover, the constitutional issues are unfounded, were not asserted in the complaint or raised below, and are not properly before this Court.

A. The Decision Below Is Based On A Correct Application Of State Law On Dispositive Issues Of Untimeliness And Failure To State A Claim.

Although petitioner asks this Court to consider only constitutional issues, such issues need not be reached because the judgment below rests on a correct resolution of state law issues dispositive of petitioner's case.

First of all, the court below correctly determined in accordance with settled principles of law that Delaware law governed the issue of whether petitioner timely commenced suit against Du Pont for its denial of bonuses to him. Since New Jersey was the forum, its choice of law rules applied. *Klaxon Co. v. Stentor Electric Manufacturing Co.*, 313 U.S. 487 (1941). New Jersey's choice of law rule for selecting which state's law governs limitations issues was set forth in *Heavner v. Uniroyal, Inc.*, 63 N.J. 130, 141, 305 A.2d 412, 418 (1973): New Jersey applies the limitations period of another state when the cause of action arose in another state, the parties were subject to jurisdiction there, New Jersey has no substantial interest in the matter, and the other state's substantive law applies. In the case at bar, the district court found, on the basis of the allegations of the verified complaint and petitioner's deposition testimony, that petitioner's claims for bonuses accrued by 1970 when he lived and worked in Delaware, and at a time when New Jersey had no substantial interest in applying its law. Thus, under *Heavner*, the limitations period was governed by Delaware law. (Petition Appendix 20). Petitioner does not contest the correctness of the determination that Delaware law applied.

Equally unassailable is the lower court's conclusion that petitioner's bonus-related claims accrued no later than 1970. Under Delaware law, a cause of action accrues upon breach of a contract or commission of a tort. *Rudginski v. Pullella*, 378 A.2d 646 (Del. Super. 1977). Since the gist of petitioner's action was the failure of Du Pont to award him bonuses, the critical date for accrual of the bonus-related claims was the

date his bonus claims were denied, and he was so advised. As the court below noted, there was absolutely no question that Harden was advised of the bonus denial by 1970. His verified complaint and deposition testimony so admitted. And none of Harden's other contentions, even if accepted as true for purposes of the summary judgment motion, were sufficient under Delaware law to toll the statute of limitations under any theory. *Layton v. Allen*, 246 A.2d 794, 798 (Del. 1968); *Husband (G.T.B.) v. Wife (G.R.)*, 424 A.2d 12, 14-15 (Del. 1980).

Having identified the date of accrual of the bonus claims, the court below correctly determined that these claims were barred as untimely under Delaware law. Delaware has a specific statute of limitations governing all claims arising out of the employer-employee relationship, including claims for wages, salary, and all other benefits or advantages arising out of the employment. *Sorensen v. Overland Corp.*, 142 F.Supp. 354, 360 (D. Del. 1956), *aff'd*, 242 F.2d 70 (3d Cir. 1957). That statute, 10 Del.C. § 8111, provides one year from accrual for commencement of suit.[6] Since petitioner's bonus claims accrued in 1970, his action commenced in 1979 was untimely.[7] Similarly, insofar as the verified complaint asserted claims for equitable relief, it was barred by the doctrine of laches since under Delaware law equitable claims are governed by the analagous statute of limitations. *Vredenburgh v. Jones*, 349 A.2d 22, 36 (Del. Ch. 1975). In this Court, petitioner does not challenge the correctness of the legal authority relied on by the court below to bar the bonus-related claims.

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6 The district court found it unnecessary to decide whether the one-year statute or Delaware's three year statute for contract actions, 10 Del.C. § 8106, applied to petitioner's claims relating to denial of bonuses, since his action was untimely under either statute. (Petition Appendix 24). Petitioner's reference to a Delaware six year statute of limitations is simply incorrect; there is no such statute. (Petition 17).

7 Petitioner's contention that his action should not be held to have accrued until issuance of the last of his patents in 1971 is unavailing. Even if that date were accepted, his action would nonetheless be untimely.

Finally, petitioner's claim for wrongful termination of employment was governed by New Jersey law since New Jersey was petitioner's work place and residence at the time of his termination. The court below correctly held that since petitioner's employment was for an indeterminate term, petitioner was an employee at will. *English v. College of Medicine and Dentistry*, 73 N.J. 20, 23, 372 A.2d 295, 297 (1977). In New Jersey, an employee at will may be discharged with or without cause so long as the discharge is not contrary to a clear mandate of public policy. *Pierce v. Ortho Pharmaceutical Corp.*, 84 N.J. 58, 72, 417 A.2d 505, 512 (1980). Applying *Pierce* to the case at bar, the court held that even if Harden's termination resulted from his persistence in seeking bonuses, the termination involved merely a private dispute between Harden and his employer as to whether Harden's work merited bonuses under the terms of a company sponsored bonus program. As such, it was devoid of public import. Thus, as a matter of law, Du Pont was entitled to judgment on the wrongful termination claim.

In sum, the decision below was based entirely on state law issues governed by settled authority correctly applied to the instant case. Petitioner does not assert otherwise, nor does he seek review of the state law issues on any other ground. Petitioner's attempt to advance constitutional issues in this Court should therefore be rejected. Such constitutional issues are not necessary to decision of the present matter. *See Rescue Army v. Municipal Court*, 331 U.S. 549, 570 n. 34 (1947).

B. The Constitutional Issues Advanced By Petitioner Are Unfounded, Were Not Raised Below And Are Not Properly Before The Court.

Article I, Section 8 of the Constitution of the United States empowers Congress to promote the progress of science and the useful arts by the enactment of patent laws. Petitioner, without referring to any act of Congress pursuant to this provision, urges this Court to hold that Article I, Section 8 itself directly regulates the employer-employee relationship by requiring that

an employed inventor receive compensation in excess of salary for patents developed as part of employment, and by prohibiting agreements which require employees to assign work-related inventions to their employers.

This Court should not address the constitutional issues asserted in the Petition. They were not raised in the complaint or argued below. *See Tennessee v. Dunlap*, 426 U.S. 312, 314 n. 2 (1976); *Ernst & Ernst v. Hochfelder*, 425 U.S. 185, 193 n. 13 (1976).

Moreover, the asserted constitutional arguments lack merit. Despite petitioner's contrary assertions, this Court has consistently held that the public interest, not the inventor's, is the dominant interest and the main object of the patent laws. *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) ("The copyright law, like the patent statute, makes reward to the owner a secondary consideration."); *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661, 665 (1944); *Motion Picture Patents Co. v. Universal Film Manufacturing Co.*, 243 U.S. 502, 511 (1917). Their primary purpose is to benefit the public by securing full disclosure of an invention so that upon the expiration of the life of the patent, others may practice it. In return for the disclosure, a limited monopoly is given. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-481 (1974). Thus, petitioner's basic argument—that Article I, Section 8 is intended to protect an inventor's interest, and therefore requires guaranteed recompense to employed inventors over and above their salaries—is based on a false premise as to the purpose of the patent power granted to Congress, and must fail.

Petitioner does not expressly seek to challenge any particular act of Congress. Nonetheless, the arguments urged before this Court must be examined in light of the constitutional delegation of authority to Congress to regulate patent matters.

> "The direction of Art. I. is that *Congress* shall have the power to promote the progress of science and the useful arts. Where, as here, the Constitution is permissive, the

> sign of how far Congress has chosen to go can only come from Congress."

(Emphasis in original). *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 530 (1972). Congress has spoken on the issues sought to be raised by petitioner. Under 35 U.S.C. § 261, patents and patent applications are assignable by written instrument. As this Court noted in *Transparent-Wrap Machine Corp. v. Stokes & Smith Co.*, 329 U.S. 637, 642-643 (1947), Congress has not limited or specified the consideration for which a patent may be assigned. If Congress had determined that inventors should be given a guaranteed compensation, or that such extra compensation should be encouraged, it would have so provided.[8] The present patent law contains no such provision.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

THOMAS L. MORRISSEY,
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Dated: October 6, 1983.

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8 It is noteworthy that all the countries to which petitioner refers as providing such guarantees have done so by statute. *See* Neumeyer, F., "Employees' Rights In Their Inventions," 44 *J. Pat. Off. Soc'y* 674 (1962).

APPENDIX

10 Del.C. § 8111. Work, labor or personal services.

No action for recovery upon a claim for wages, salary, or overtime for work, labor or personal services performed, or for damages (actual, compensatory or punitive, liquidated or otherwise), or for interest or penalties resulting from the failure to pay any such claim, or for any other benefits arising from such work, labor or personal services performed or in connection with any such action, shall be brought after the expiration of one year from the accruing of the cause of action on which such action is based. (20 Del. Laws, c. 594; Code 1915, § 4675; Code 1935, § 5133; 46 Del. Laws, c. 114; 10 Del.C. 1953, § 8110.)

10 Del.C. § 8106. Actions subject to 3 year limitation.

No action to recover damages for trespass, no action to regain possession of personal chattels, no action to recover damages for the detention of personal chattels, no action to recover a debt not evidenced by a record or by an instrument under seal, no action based on a detailed statement of the mutual demands in the nature of debit and credit between parties arising out of contractual or fiduciary relations, no action based on a promise, no action based on a statute, and no action to recover damages caused by an injury unaccompanied with force or resulting indirectly from the act of the defendant shall be brought after the expiration of 3 years from the accruing of the cause of such action; subject, however, to the provisions of §§ 8108-8110, 8119 and 8127 of this title. (Code 1852, § 2742; Code 1915, § 4671; Code 1935, § 5129; 46 Del. Laws, c. 115, § 1; 10 Del.C. 1953, § 8106; 57 Del. Laws, c. 568, § 2.)